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Paper No. 9

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OFFICE OF PETITIONS

In re Application of: :
Calabrese et al. :
Application No. 09/558,613 : ON PETITION
Filed: 26 April, 2000 :
Attorney Docket No. Calabrese 10-3- :
7-16 :

This is a decision on the petition filed on 15 June, 2004, which is treated as a petition under 37 C.F.R. § 1.183,¹ requesting expungement of the original specification of this application.

The petition is **DISMISSED**.

Petitioners request that the original specification and claims be expunged because the specification and claims differ from what applicant believes were the specification and claims filed with the original application papers. In particular, petitioners assert that "the 35-page specification, claims, and abstract ... from the PTO file history does not match the originally-filed 30 page specification, claims, and abstract."

RULES

37 CFR 1.59 states, in pertinent part:

(a)(1) Information in an application will not be expunged, except as provided in paragraph (b) of this section.

(2) Information forming part of the original disclosure (i.e., written specification including the claims, drawings, and any preliminary amendment specifically incorporated into an oath or declaration under §§ 1.63 and 1.175) will not be expunged from the application file.

¹ "A petition to expunge a part of the original disclosure must be filed under 37 C.F.R. §1.183, since such a request requires a waiver of the requirements of 37 C.F.R. §1.59(a)." M.P.E.P. 724.05 (IV).

37 CFR 1.183 states that suspension of the rules may be granted in an "extraordinary situation, when justice requires".

ANALYSIS

The facts presented on the record do not establish an extraordinary situation. Petitioners have not established any special circumstances or equities that would require suspension of the rules in the interests of justice.

Petitions to expunge information forming part of the original disclosure must explain why justice requires waiver of the rules to permit the requested material to be expunged. These petitions are not normally decided in favor of the petitioner. Part of the reason is that "[t]he original disclosures of applications are scanned for record keeping purposes. Accordingly, the grant of a petition to expunge information which is part of the original disclosure would require that the PTO record of the originally filed application be changed, which may not be possible."²

The arguments have been considered, but are not persuasive. The U.S. Patent and Trademark Office (Office) file is the official record of the papers originally filed in this application. A review of the papers originally filed reveals that 35 pages of specification, including 54 claims and one (1) page of abstract, were filed on 26 April, 2000.

An applicant alleging that a paper was filed in the Office and later misplaced has the burden of proving the allegation by a preponderance of the evidence. Where the records of the Office (e.g. the file of the application) contain any document(s) or fee(s) corresponding to the contents of the correspondence at issue, the Office will rely upon its official record of the contents of such correspondence in the absence of convincing evidence (e.g. a postcard receipt under MPEP 503 containing specific itemization of the document(s) or fee(s) purported to have been filed with the correspondence at issue) that the Office received and misplaced any document(s) or fee(s) that is not among the official records of the Office. If a new application is being filed, all parts of the application being submitted should be separately listed on the postcard, e.g., the number of pages of specification (including written description, claims and abstract) number of claims, number of sheets of drawings, number of pages of oath/declaration. The postcard receipt will not

² *Id.*

serve as *prima facie* evidence of receipt of any item which is not adequately itemized on the postcard.³

In summary, the contents of the USPTO application file constitute the official record of what was filed in an application. Absent sufficient proof to the contrary, the USPTO will rely upon the written record as evidence of what was filed in the application. In the present situation, petitioners have provided no proof that the 35 pages of specification, including 54 claims and one (1) page of abstract, located in the official file are not the application papers received on 26 April, 2000. Absent evidence to the contrary (i.e., an itemized return receipt postcard), petitioners have no proof that the application papers in the file are different from the papers which petitioners filed. The mere fact that the papers constituting the original disclosure differ from what applicant believes he filed does not, in itself, constitute extraordinary circumstances where justice requires waiver of the rule.

Furthermore, the mere fact that the application papers in this application may be identical or similar to the application papers filed in another application is not persuasive evidence that the USPTO mishandled the application papers filed in this case. Rather, the evidence suggests that applicant may have inadvertently misfiled papers in the present application.

The petition is dismissed without prejudice to reconsideration pending submission of an itemized postcard or other persuasive evidence supporting petitioners' contention that 30 pages of specification, including 56 claims and one (1) page of abstract, were filed on 26 April, 2000.

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³MPEP 503.

Application No. 09/558,613

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Telephone inquiries related to this decision should be directed
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